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09/220,284 12/23/98 WRIGHT G JWRIGHT.008C

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EXAMINER

RONES, C

ART UNIT

PAPER NUMBER

2771

DATE MAILED:

09/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/220,284

Applicant(s)

WRIGHT, JR. et al.

Examiner
Charles Rones

Group Art Unit
2771



☒ Responsive to communication(s) filed on Dec 23, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/666,422, filed on June 18, 1996.

Specification

2. Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

The cross reference to the continuing application should be statused to included the patent issue number and date.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Reisman US Patent 5,694,546 ('Reisman').

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5. As to claim 1, Reisman discloses:

a. a client database; See 12:59-65; 14:1-35; and

b. a communications module; See 2:60-67; 6:34-37; 16:11-15; and

c. a server computer; See 2:60-67; 6:34-37; 16:11-15;

d. a data storage; See 10:54-58;

e. a session module, in communication with the data storage, to non-persistently connect to the communications module and access the client database from time to time; See Fig. 6; 1:12-67; 16:11-49.

6. As to claim 2, Reisman discloses:

a. wherein access of the client database by the session module is a query; See 12:1-4; 14:26-40.

7. As to claim 3, Reisman discloses:

a. wherein the access of the client database by the session module is to add data to the client database; See 2:1-66; 21:2-7.

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8. As to claim 4, Reisman discloses:

a. wherein the adding of data updates a work order in the client database wherein it is deemed inherent where updating a work order is consider updating data; See 20:1-40.

9. As to claim 5, Reisman discloses:

a. wherein the adding of data provides electronic mail to the client database; See 2:48-59.

10. As to claim 6, Reisman discloses:

a. wherein the access of the client database by the session module is to remove data from the client database; See 16:49-65.

11. As to claim 7, Reisman discloses:

a. wherein a portion of the client database is retrieved and stored in the data storage; See 20:1-35.

12. As to claim 8, Reisman discloses:

a. wherein the data storage comprises a mail server so that the client computer can access electronic mail to the client database wherein the server is having an information transport for transmitting electronic information is deemed to inherently include a mail server or a server used for mail; See 2:1-67; 10:15-67.

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13. As to claim 9, Reisman discloses:

a. wherein the data storage resides on a local area network that is further connected to the server; See 15:10-32.

14. As to claim 10, Reisman discloses:

a. wherein the session module has a persistent connection with the data storage wherein a network connection to data storage is deemed to be a persistent connection to the data storage; See 1:20-67; 2:1-67; 5:40-67.

15. As to claim 11, Reisman discloses:

a. connecting one of the mobile clients to a server having a session module; See 7:1-23; 9:34-44; 10:59-67;

b. manipulating the client database with the session module; See 7:1-67; 9:34-44; 10:59-67;

c. updating the data storage responsive to the manipulation by the session module; See 7:1-67; 9:34-44; 10:59-67;

d. disconnecting the client from the server; See 16:43-49; Figs. 5-6; and

e. repeating (a)-(d) a plurality of times, each time with a different one of mobile clients; See 11:1-67.

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16. As to claim 12, Reisman discloses:

a. additionally comprising updating the client database with data obtained from data storage; See 10:53-59.

17. As to claim 13, Reisman discloses:

a. wherein the manipulating includes querying the client database for specific data stored in the client database; See Figs. 5-6; 7:1-67; 11:24-67; 20:10-45.

18. As to claim 19, Reisman discloses:

a. wherein the data storage resides on a wide area network; See 2:9-67.

19. As to claim 20, Reisman discloses:

a. wherein the wide area network is the Internet; See 2:9-67.

20. As to claim 21, Reisman discloses:

a. wherein the data storage includes data that is shareably accessed by the plurality of mobile clients; See 7:1-67; 9:34-44; 10:59-67.

21. As to claim 30, Reisman discloses:

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a. wherein each one of the session modules executes a set of tasks which is different from the set of tasks of the other session modules; See 4:9-42; 15:10-54.

22. As to claims 14-18 & 20-29, they are combinations and subcombination of previously rejected claims and are rejected for their respective reasons as set forth above.

23. In the alternative, if Applicant argues that Reisman is insufficient to show that the capabilities existed at the time of the Applicant's invention, then Examiner takes "**Official Notice**" that Applicant claims have existed prior to June 19, 1996.

24. Section 2144.03 of the MPEP states that Reliance on Common Knowledge in the Art or "Well Known" Prior Art [R - 1]

25. The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well - known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well - known" in the art. In re Ahlert , 424 F.2d 1088, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that "it is common practice to postheat a weld after the welding operation is completed" and that "it is old to adjust the intensity of a flame in accordance with the heat requirements."). See also In re Seifreid , 407 F.2d 897, 160 USPQ 804 (CCPA 1969)

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(Examiner's statement that polyethylene terephthalate films are commonly known to be shrinkable is a statement of common knowledge in the art, supported by the references of record.).

26. If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In re Malcolm , 129 F.2d 529, 54 USPQ 235 (CCPA 1942). If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

27. When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.107.

28. As to claim 1, Examiner states that Lotus' cc:Mail product discloses:

a. a client database wherein the ccMail remote user application consisted of a client mail database; and

b. a communications module wherein the ccMail remote user application connects to a ccMail gateway or router; See ; and

c. a server computer where the ccMail host database (home) resides on a server computer; See ;

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d. a data storage wherein the ccMail database (home) contained storage for the ccMail home database; See ;

e. a session module, in communication with the data storage, to non-persistently connect to the communications module and access the client database from time to time wherein the ccMail gateway/router software was scheduled to make calls to remote post office clients and remoter mobile mail users periodically.

29. As to claim 2, Examiner states that Lotus' cc:Mail product discloses:

a. wherein access of the client database by the session module is a query wherein the gateway/router contained a session module which can be stored either on the gateway/router or on the data storage having the ability to query the scheduler to communicate with remote clients.

30. As to claim 3, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the access of the client database by the session module is to add data to the client database wherein the host ccMail database connects to remote post office clients and remote ccMail mobile clients to update their mail directories (databases), which includes adding and deleting users to the mail directory and exchange e-mail with a separate database.

31. As to claim 4, Examiner states that Lotus' cc:Mail product discloses:

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a. wherein the adding of data updates a work order in the client database wherein it is deemed that the data exchanged is data which can inherently consist of any data including a work order.

32. As to claim 5, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the adding of data provides electronic mail to the client database; See response to claim 3 above.

33. As to claim 6, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the access of the client database by the session module is to remove data from the client database; See response to claim 3 above.

34. As to claim 7, Examiner states that Lotus' cc:Mail product discloses:

a. wherein a portion of the client database is retrieved and stored in the data storage wherein it is deemed that a home post office can retrieve a portion of the remote post office's directory (database) and store it in the home post offices data storage .

35. As to claim 8, Examiner states that Lotus' cc:Mail product discloses:

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a. wherein the data storage comprises a mail server so that the client computer can access electronic mail to the client database wherein the home ccMail post office is deemed to reside on a server (mail server).

36. As to claim 9, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the data storage resides on a local area network that is further connected to the server wherein the ccMail home post office is deemed to reside on a local network wherein the local users access their home post office via the local area network.

37. As to claim 10, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the session module has a persistent connection with the data storage where in the local area network is deemed to comprise of a persistent connection for local users to the ccMail home (local) post office.

38. As to claim 11, Examiner states that Lotus' cc:Mail product discloses:

a. connecting one of the mobile clients to a server having a session module; See response to claims 1-3 above;

b. manipulating the client database with the session module; See response to claims 1-3 above;

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c. updating the data storage responsive to the manipulation by the session module; See response to claims 1-3 above;

d. disconnecting the client from the server wherein it is deemed that the ccMail gateway/router connects to remote post offices and remote mobile users and disconnects from them either as their dial in or as they are polled; See ; and

e. repeating (a)-(d) a plurality of times, each time with a different one of mobile clients wherein it is deemed that different remote post offices and mobile users are contacted through a ccMail router/gateway via a scheduler either on the home post office or the mobile clients.

39. As to claim 12, Examiner states that Lotus' cc:Mail product discloses:

a. additionally comprising updating the client database with data obtained from data storage wherein the home (central) post office is deemed to store its data on data storage which updates the mail directories and e-mail messages on mobile client databases.

40. As to claim 13, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the manipulating includes querying the client database for specific data stored in the client database wherein it is deemed that the remote client's directory is manipulated which includes query to see what differences exist or if a particular e-mail name is stored on the client database and synchronizing the change is so desired by the central post office wherein the client databases are subordinate to the central database (post office).

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41. As to claim 19, Examiner states that Lotus' cc:Mail product discloses:

a. wherein the data storage resides on a wide area network wherein ccMail can connect with remote connection through-out the world using the Internet or phone lines (PBX) or ATM.

42. As to claim 20, Reisman discloses:

a. wherein the wide area network is the Internet; See response to claim 19.

43. As to claim 21, Reisman discloses:

a. wherein the data storage includes data that is shareably accessed by the plurality of mobile clients; See response to claims 1-3 above.

44. As to claim 30, Reisman discloses:

a. wherein each one of the session modules executes a set of tasks which is different from the set of tasks of the other session modules wherein it is deemed that ccMail contains a scheduler which can execute task different from other session's takes over the session module.

45. As to claims 14-18 & 20-29, they are combinations and subcombination of previously rejected claims and are rejected for their respective reasons as set forth above.

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Double Patenting

46. Claims 1-10 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 5 of prior U.S. Patent No. 5,553,282. This is a double patenting rejection.

47. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

48. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,857,201. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claim 1-10 of Wright, Jr. et al. '201 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a

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combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *In re Karlson*, 136 USPQ 184.

Conclusion

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Rones whose telephone number is (703) 306-3030. The examiner can normally be reached on Monday through Thursday from 8 a.m. to 4 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached on (703) 305-9707.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

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Or:

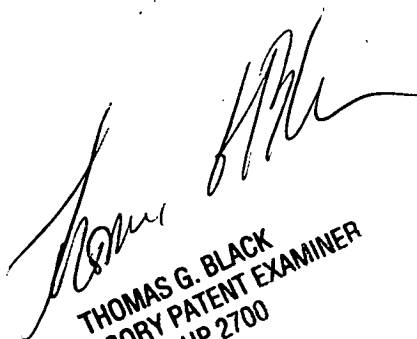
(703)308-5403 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be
directed to the Group receptionist whose telephone number is (703) 305-3900.


Rones

September 6, 1999


THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 2700